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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/635,824	08/10/2000	Bei-Hong Liang	IP-5551	6032
7590 06/25/2004				
Joseph W. Berenato III Liniak, Berenato, Longacre & White LLC 6550 Rock Spring Drive Suite 240 Bethesda, MD 20817			EXAMINER FERGUSON, LAWRENCE D	
			ART UNIT 1774	PAPER NUMBER
DATE MAILED: 06/25/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/635,824

Applicant(s)

LIANG ET AL.

Examiner

Lawrence D Ferguson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 and 50-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 50-55 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-19 and 23-30 is/are rejected.
- 7) ☒ Claim(s) 4 and 20-22 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Request for Reconsideration***

1. This action is in response to the request for reconsideration mailed November 26, 2003. Claim 1 was amended and claims 50-55 were added. Examiner withdraws the previous rejections to further prosecute the claimed invention. Claims 1-30 and 50-55 are pending in this case.

### ***Claim Rejections – 35 USC § 103(a)***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-3, 5-19 and 23-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Druecke et al (U.S. 6,187,137).

Druecke discloses a fibrous article comprising hemp or kenaf fibers having a density of 0.33g/cc or greater (column 8, lines 49-65) which meets the limitation of the article having a density of at least about 45 lb/ft<sup>3</sup>. Druecke further discloses the fibrous article comprises a resinous adhesive (column 5, lines 1-30) that is dried and heated (cured) (column 11, lines 17-24). Because the fibrous article of Druecke comprises the

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same materials having the same functions as instantly claimed, it is inherent that the fibrous article of Druecke, comprises a moisture content, specific gravity, sizing agent, cleavage, internal bond strength and smoothness as claimed by Applicant. The claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Mere recitation of newly-discovered function or property, inherently possessed by things in prior art, does not cause claim drawn to those things to distinguish over prior art; Patent Office can require applicant to prove that subject matter shown to be in prior art does not possess characteristic relied on where it has reason to believe that functional limitation asserted to be critical for establishing novelty in claimed subject matter may be inherent characteristic of prior art; this burden of proof is applicable to product and process claims reasonably considered as possessing allegedly inherent characteristics.

Druecke does not explicitly teach the weight percent of the binder resin. With regard to the limitation of the weight percentage, absent a showing of unexpected results, it is obvious to modify the conditions of a composition because they are merely the result of routine experimentation. The experimental modification of prior art in order to optimize operation conditions (e.g. weight percentage) fails to render claims patentable in the absence of unexpected results. The weight percent of the resin binder is optimizable as it directly affects the mechanical strength and resiliency of the fibrous article. As such, it is optimizable. It would have been obvious to one of ordinary skill in the art to make the fibrous article with the limitations of the resin binder weight percent

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since it has been held that discovering an optimum value of a result effective variable involves only routine skill in the art. *In re Boesch*, 617 USPQ 215 (CCPA 1980).

6. Claims 4 and 20-22 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. Claims 50-55 are allowable.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Wasylciw teaches a fibrous article comprising hemp hurd having a binder and density greater than 45 lb/ft<sup>3</sup> (column 1, line 47 through column 2, line 6), where the size of the hurd may be varied and the hurd strands have a length less than 20 and 30mm by cutting the material (column 3, lines 16-59).

### ***Response to Arguments***

9. Applicant's remarks to rejection made under 35 U.S.C. 102(b) as being anticipated by Seale et al. (U.S. 5,492,756) have been considered and are moot based on grounds of new rejection.

Applicant's remarks to rejection made under 35 U.S.C. 103(a) as being unpatentable over Seale et al. (U.S. 5,492,756) in view of WO 00/69607 (WO '607) have been considered and are moot based on grounds of new rejection.

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10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

### ***Conclusion***

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lawrence Ferguson whose telephone number is 571-272-1522. The examiner can normally be reached on Monday through Friday 9:00 AM – 5:30PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cynthia Kelly, can be reached on 571-272-1526. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Lawrence D. Ferguson  
Examiner  
Art Unit 1774

CYNTHIA H. KELLY  
SUPERVISORY PATENT EXAMINER  
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